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PTO/SB/33 (07-05)

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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

04AB026/SWA (ALBR:0142)

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on May 18, 2007

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Seanelle Dice

Application Number

10/718,021

Filed

November 19, 2007

First Named Inventor

Brian J. Taylor

Art Unit

2836

Examiner

Dharti H. Patel

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐

applicant/inventor.

☐

assignee of record of the entire interest.

See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

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attorney or agent of record.

Registration number 48,226

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attorney or agent acting under 37 CFR 1.34.

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Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

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*Total of 1 forms are submitted.

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:
Brian J. Taylor

Serial No.: 10/718,021

Filed: November 19, 2003

For: MODULAR ON-MACHINE
CONTROLLER

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Group Art Unit: 2836

Examiner: Dharti H. Patel

Atty. Docket: 04AB026/SWA
ALBR:0142

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May 18, 2007
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Seanelle Dice

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Dear Sir:

With respect to the Final Office Action mailed on February 26, 2007, Appellant respectfully submits this Pre-Appeal Brief Request for Review. This Request is being filed concurrently with a Notice of Appeal.

In the Final Office Action, the Examiner rejected pending claims 1-9, 12-21, 24-34, 51-56, and 59-63 under 35 U.S.C. § 102(e) as being anticipated by Knox et al. (U.S. Pat. App. Serial No. 10/494,714) and rejected claims 10-11, 22-23, and 57-58 as being obvious over the Knox reference in view of Hollenbeck et al. (U.S. Pat. No. 5,557,182). Of these, claims 1, 16, 27, 31, 34, and 51 are independent. In the Final Office Action, the Examiner essentially reiterated the rejection formulated in the previous non-final Office Action. Appellant respectfully traverses these rejections in view of the clear legal and factual deficiencies discussed in detail below.

Embodiments of the present application relate to on-machine control of a machine. Application, page 1, lines 26-27. The on-machine control involves a machine-mountable base unit having a machine protection device and a modular, replaceable control unit. Application,

page 1, lines 27-28. The machine protection device may include a short-circuit protection device. Application, page 5, lines 20-22. Furthermore, the control unit may be selected from a variety of different modular control units having different control features. Application, page 6, lines 15-17. As the control unit is configured to control the machine, it may include an output connector for interfacing with the machine. Application, page 9, lines 18-20. Accordingly, independent claims 1, 16, 27, 31, 34, and 51 and the claims depending therefrom recite combinations of these various features, among others.

The Control Unit Contains Circuitry Configured to Control the Machine/Motor

Turning to the claims, independent claim 1 recites, *inter alia*, “wherein the modular control unit comprises control circuitry configured to control the machine.” Independent claim 16 recites, *inter alia*, “wherein the replaceable control unit comprises control circuitry configured to control a motor.” Independent claim 27 recites, *inter alia*, “wherein the modular control unit comprises control circuitry configured to control at least one machine in the machine system.” Independent claim 31 recites, *inter alia*, “wherein the selectable control unit comprises control circuitry configured to control at least one machine in the machine system.” Independent claim 34 recites, *inter alia*, “wherein the modular control unit comprises control circuitry configured to control at least one machine in the system of distributed machines.” Independent claim 51 recites, *inter alia*, “wherein the control circuitry is configured to control the motor.” (Emphasis added in all quotations.)

Appellant respectfully reminds the Panel that, for a prior art reference to anticipate under Section 102, every element of the claimed invention must be identically shown in a single reference. *In re Bond*, 910 F.2d 831, 15 U.S.P.Q.2d 1566 (Fed. Cir. 1990). In contrast to the above recitations, the Knox reference discloses a user interface module 2 for interacting with a motor overload protector (MOP) 1. *See* col. 6, paragraph 103. This user interface 2 does not control the motor to which the MOP 1 is applied. At best, the user interface 2 may be used for programming the MOP 1. *See id.* The Examiner asserted that a user may “enter[] a command into the user interface to start the motor ... or to shut down the motor,” and the command is “sent from microcontroller 75 to digital signal processor DSP 55, which in turn controls the motor.” Final Office Action, pages 15-16. First, this statement is misleading, as nowhere in Knox is this

kind of control described. On the contrary, Knox discloses a motor overload protector, which merely prevents the motor from overheating, not a motor controller. In addition, the Examiner specifically stated that the DSP 55, which is not a component of the user interface 2, controls the motor. Thus, the Examiner's own statements regarding the user interface 2 and the DSP 55 contradict one another.

Accordingly, Appellant respectfully asserts that the Knox reference fails to disclose all of the recited features of independent claims 1, 16, 27, 31, 34, and 51, and thus, the Knox reference cannot possibly anticipate the recited subject matter. Therefore, Appellant respectfully asserts that the Examiner's rejection is in clear error.

The Motor Protection Device may be a Short-Circuit Protection Device

Independent claim 16 recites, *inter alia*, "a motor mountable base comprising a short-circuit tripping disconnect." Independent claim 34 recites, *inter alia*, "a machine mountable base, comprising: a short-circuit protective device." Dependent claim 2 recites, "wherein the motor protection device comprises a short-circuit protective device." (Emphasis added in all quotations.)

In contrast, the Knox reference discloses a motor overload protector. *See* page 1, paragraph 1. The Knox reference does not disclose that the MOP 1 includes short-circuit protection. Rather, the Knox reference relates to motor overload protection. Overload protection does not necessarily include short circuit protection in accordance with the ordinary meaning of the term. *See* MCGRAW HILL DICTIONARY OF SCIENTIFIC AND TECHNICAL TERMS 1507 (6th Ed. 2003). Furthermore, nothing in the Knox reference indicates that short-circuit protection was meant to be included in or is provided by the MOP 1. For example, the Background of the Invention section describes the problem to be solved as increasing the accuracy and automation of monitoring motor currents to predict motor heating. *See* page 1, paragraph 1. Trip contact relay 66 and line fuses 68, cited by the Examiner as short-circuit protective devices, are not described as such in the Knox reference, nor is there any reason to believe they perform such a function. *See* page 6, paragraphs 101-102.

Accordingly, Appellant respectfully asserts that the Knox reference fails to disclose all of the recited features of independent claims 16 and 34, and dependent claim 2, and thus, the Knox reference cannot possibly anticipate the recited subject matter. Therefore, Appellant respectfully asserts that the Examiner's rejection is in clear error.

The Control Unit Includes an Output Connector Configured to Couple with the Machine/Motor

In addition to the above-cited features of the independent claims which are omitted from the Knox reference, dependent claims 64, 66, 68, 70, 72, and 74, depending from independent claims 1, 16, 27, 31, 34, and 51, respectively, recite that the “control unit comprises an output connector configured to couple with” the machine or motor which is being controlled. (Emphasis added). With respect to the Knox reference, the Examiner stated, “[T]he output connector is on the bottom surface of user interface 2, which detachably connected to user interface pedestal 22 in the remote mount configuration, par. 0087 and 0088. The male portion of the connector is shown in Fig. 2 as comprising 16, 23, and 24.” Final Office Action, pages 11-12. The Examiner also stated that “the output connector is coupled to the motor via transmission through the user interface umbilical 21, Fig. 2.” *Id* at 12. Furthermore, the Examiner identified the cable 19 of the user interface umbilical 21 as a cable by which the “control unit” could be coupled to a machine. *Id* at 13.

The Examiner has erroneously identified features of Knox which are used to connect the user interface 2 to the motor overload protector 1, not to a machine or motor being controlled. *See* pages 4-5, paragraphs 87-88; Fig. 2. The cable 19 is part of the user interface umbilical 21, which allows for remote mounting of the user interface 2. *See id*. Nothing in Knox teaches that the user interface 2 has an output connector configured to couple with a motor or machine. On the contrary, the entire purpose of the user interface 2 is to interface with the motor overload protector 1, therefore there is no reason for the user interface 2 to include an output connector configured to couple with a motor or machine.

Accordingly, Appellant respectfully asserts that the Knox reference fails to disclose all of the recited features of dependent claims 64, 66, 68, 70, 72, and 74, and thus, the Knox reference cannot possibly anticipate the recited subject matter. Therefore, Appellant respectfully asserts that the Examiner’s rejection is in clear error.

The Control Unit is Interchangeable with Different Control Units

Dependent claims 65, 67, 69, 71, 73, and 75, depending from independent claims 1, 16, 27, 31, 34, and 51, respectively, recite, “wherein the ... control unit is selected from and interchangeable with a plurality of ... control units, each having different control circuitry.”

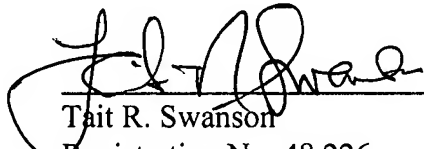
(Emphasis added). In sharp contrast, the Knox reference discloses a single user interface 2 configured to operate with the motor overload protector 1. The user interface umbilical 21 may be added to the system, however the same user interface 2 is still used to interface with the motor overload protector 1.

In the Final Office Action, the Examiner stated, “[O]ne removable user interface 2 can be switched out and replaced with another identical unit if it fails Each user interface 2 is a self-contained module, which means that each has its own ‘different control circuitry’ from another.” Final Office Action, page 12 (emphasis added). The Examiner’s reasoning is clearly flawed, as “identical” units cannot be “different.” On the contrary, “different” is defined as “not identical.” THE RANDOM HOUSE COLLEGE DICTIONARY 370 (Rev. Ed. 1988). Furthermore, this plain meaning of the term “different” is clearly supported in the specification, in which varying control features and components are described in the control units. *See* Specification, page 6, line 15 – page 8, line 11; Figs. 2-3.

Accordingly, Appellant respectfully asserts that the Knox reference fails to disclose all of the recited features of dependent claims 65, 67, 69, 71, 73, and 75, and thus, the Knox reference cannot possibly anticipate the recited subject matter. Therefore, Appellant respectfully asserts that the Examiner’s rejection is in clear error.

Respectfully submitted,

Date: May 18, 2007



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